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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,231	08/08/2001	Ruth E. Rosenholtz	110268	9878
27074	7590	08/25/2004	EXAMINER	
OLIFF & BERRIDGE, PLC. P.O. BOX 19928 ALEXANDRIA, VA 22320			TRAN, QUOC A	
			ART UNIT	PAPER NUMBER

2176

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/682,231

Applicant(s)

ROSENHOLTZ ET AL.

Examiner

Quoc A. Tran

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 04/19/2002, 08/01/2002, 11/30/2002
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to application filed 08/08/2001.
2. Claims 1-8 are currently pending in this application. Claims 1, and 6 are independent claims.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-4, are rejected under 35 U.S.C. 101 because the claimed invention is not embodied on a computer readable medium, nor are the "executable instructions" explicitly recited as being carried out, or functionally tied in, to a computer environment as recited in the preamble, "method of displaying a document associated with a thumbnail generated base on an original document". Therefore, the claims read on a mental construct/abstract idea or at best a computer program, per se.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being unpatentable by Hahn et al. US Patent No. 5,751,287 issued 05/12/1998 filed 11/06/1995 (hereinafter '287).

In regard to independent claim 1, *" displaying the thumbnail, receiving a request to display a document associated with the thumbnail, displaying a first version of the document, at least a portion of the first version being more similar in appearance to a corresponding portion of the thumbnail than a corresponding portion of the original document "*, as taught by '287 at col. 11, lines 30-55 (i.e. FIG. 16 illustrates a display of a document stored within a file cabinet according to a preferred embodiment of the present invention. FIG. 16 includes open file folder window 1680 and document window 1690. Window 1680 includes document icon 1700... window 1690 is displayed to the user. Window 1690 preferably includes a thumbnail region 1710 which gives a "thumbnail" view of the pages in the document. In FIG. 16, thumbnail view 1730 has been selected and the page of the document associated with thumbnail view 1730 is displayed in the document view region 1720).

In regard to dependent claim 2, *"displaying a second version of the document in which a portion corresponding to the at least a portion of the first version is more similar to the corresponding portion of the original document"*, as taught by '287 at col. 11, lines 55-55 (i.e.... To display different parts of the document in document view region 1720, vertical scroll bars 1740 are manipulated in well-known methods. The user may directly select any of the thumbnails in thumbnail region 1710, for display in document view region 1720).

In regard to dependent claim 3, *"The method according to claim 2, wherein the second version is substantially identical to the original document."*, as taught by '287 at col. 11, lines 45-50 (i.e..... "thumbnail" view of the pages in the document. In FIG. 16, thumbnail view 1730 has been selected and the page of the document associated with thumbnail view 1730 is displayed in the document view region 1720...).

In regard to dependent claim 4, *" wherein the corresponding portion of the thumbnail comprises an element modified during generation of the thumbnail "*, as taught by '287 at col. 12, lines 30-40 (i.e. Function buttons 1850 and 1860 allow the user to view the thumbnail image to the right of the current selected page or to left of the ... To delete selected pages, the user selects a thumbnail image and then hits a delete key or selects function button 1870...).

In regard to dependent claim 5, is directed to a storage medium for performing the method of claim 1, and is similarly rejected along the same rationale.

In regard to independent claim 6, is directed to an apparatus for performing the method of claim 1, and is similarly rejected along the same rationale.

In regard to dependent claim 7, is directed to an apparatus for performing the method of claim 2, and is similarly rejected along the same rationale.

In regard to dependent claim 8, is directed to an apparatus for performing the method of claim 3, and is similarly rejected along the same rationale.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Brown et al U.S. Patent No. 6,356,908 B1 issued 03/12/2002 filed 07/30/1999
Anderson et al U.S. Patent No. 5,917,488 issued 06/29/1999 filed 08/21/1996

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quoc A. Tran whose telephone number is (703) 305-8781, **"After mid-Oct, 2004, the examiner can be reach at (571) 272- 4103"**. The examiner can normally be reached on Monday through Friday from 8:30AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Quoc A. Tran
Patent Examiner
Technology Center 2176
August 19, 2004


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER